REMARKS

Claims 1-16 are pending and were rejected. In view of the arguments presented below, reconsideration of the application is respectfully requested.

Claims 1, 7, 8, 14, 15, and 16 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Chien* (U.S. 6,393,445). Applicants respectfully traverse this rejection.

The rejection asserts that the abstract of Chien discloses all elements of claim 1. Applicants were unable, however, to locate all elements of claim 1 in the abstract of Chien, or anywhere else in the Chien reference. For instance, claim 1 requires that "any items in double-byte form in at least a first of the databases which are convertible into the common format in multiple ways being converted in all those ways in a first string of representations." Chien does not disclose converting an item in double-byte form in all possible ways into a first string of representations—each teaching of Chien performs a one-for-one transformation.

Furthermore, claim 1 requires comparing the data items in the common format (which now can include data items converted in multiple ways, see Applicants' Figure 5 for a simple example) to a second string of representations. Chien does not disclose comparing strings of representations—he simply converts characters from one form to another and displays the result. Applicant can find no reference in the Chien abstract to support the rejection's assertion regarding the comparison of strings of representations.

Claim 7 depends from claim 1, and adds a limitation that upon finding a match, an item in the first database is removed. The rejection fails to identify where in Chien such a limitation is taught, and Applicants can find no such teaching in Chien. It does not appear that Chien ever removes an item from a database.

With respect to claim 8, the rejection fails to identify where in Chien the two recited conversion units and comparison unit are taught, and Applicants can find no such teaching. Chien does not appear to teach, among other claim 8 limitations, a first conversion unit that converts any items in a double-byte form in a first database convertible in multiple ways in all those ways in a string of representations, or a comparison unit for the converted items.

Claims 14 and 15 depend from claim 8. Claim 14 adds a limitation that the comparison unit is arranged such that, upon detecting a match, it operates output means to signal that the

first database unit should be removed. Claim 15 adds a limitation that the comparison unit is arranged such that, upon detecting a match, it removes the corresponding item from the first database. The rejections fail to identify where in Chien such limitations are taught, and Applicants can find no such teachings in Chien. It does not appear that Chien ever removes an item from a database.

Claim 16 contains similar language to that identified for claims 1 and 8 above as not taught by Chien.

For at least the foregoing reasons, Applicants respectfully submit that Chien fails to disclose all limitations of claims 1, 7, 8, 14, 15, and 16, as is required for anticipation under 35 U.S.C. § 102. Accordingly, Applicants request that the rejection of these claims be withdrawn.

Claims 2-6 and 9-13 were rejected under 35. U.S.C. § 103(a) as unpatentable over Chien. Applicants respectfully traverse this rejection on the grounds that a *prima facie* case of obviousness is lacking for any of these claims.

A proper *prima facie* case must demonstrate all claim elements as existing in the prior art, indicate a prior art teaching or suggestion for combination of these elements, and demonstrate that any modification have a reasonable expectation of success.

At the outset, Applicants note that claims 2-6 and 9-13 each depend from either claim 1 or claim 8 addressed above. As Chien fails to teach or suggest each element of claims 1 and 8, Chien necessarily cannot create a *prima facie* case of obviousness for a claim dependent on claim 1 or 8.

With respect to claims 2 and 9, Applicants respectfully disagree with the Examiner's assertion that the claimed use of Pin Yin characters as the common Chinese language format is obvious. Chien only converts between character forms having a one-to-one correspondence. Because of the lack of one-to-one correspondence between Pin Yin characters and Chinese character forms such as those disclosed in Chien, the Examiner has not demonstrated that one of ordinary skill would expect a modification to be successful. As a reasonable expectation of successfully modification is required in a *prima facie* case, Applicants respectfully submit that a *prima facie* case is lacking at least for this reason. Furthermore, nothing in Chien would suggest outputting *multiple* Pin Yin characters for an input Chinese character form with multiple corresponding Pin Yin characters, as is fairly implied by the claims.
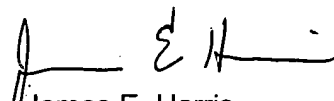
With respect to claims 3, 5, 6, 10, 12, and 13, the Examiner's position appears to be that because one of ordinary skill in the art would know that databases can be set up to store desired information, it would be obvious to add the limitations of claims 3, 5, 6, 10, 12, and 13 to Chien's teachings. This assertion is insufficient to create a *prima facie* case. For instance, with respect to claims 3 and 10, the Examiner has not indicated a prior art suggestion to modify Chien from its graphical usage to a usage for converting order management system entries to strings of representations, with data items convertible in multiple ways converted in all such ways. Nor does the mere knowledge that databases store information teach the application of this claimed order management system usage with the recited claim elements. The prior art simply fails to teach the claimed technique for comparing databases.

Likewise, with respect to claims 5 and 12, the general knowledge that databases exist, when combined with Chien, fails to suggest the claimed method for identifying whether database entries correspond to proscribed parties issued by a governmental organization. Nor, with respect to claims 6 and 13, does the Examiner's combination suggest *not* converting a data item that does not include an address within a Chinese territory.

Accordingly, Applicants respectfully submit that Chien fails to create a *prima facie* case of obviousness for claims 2-6 and 9-13. Applicants respect that this rejection be withdrawn.

In view of the above, it is respectfully submitted that remaining claims 1-16 are in condition for allowance. Accordingly, a Notice of Allowance is courteously solicited.

Respectfully submitted,

James E. Harris
Registration No. 40,013

Dated: 1/18/06
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8502
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on   Jan 18, 2006
Date

Susan C. Lien